

Appln No. 10/815,612
Amdt. Dated January 9, 2006
Response to Office Action of November 1, 2005

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REMARKS/ARGUMENTS

The Office Action has been carefully considered. The issues raised are traversed and addressed below with reference to the relevant headings and paragraph numbers appearing under the Detailed Action of the Office Action.

Claim Rejections – 35 U.S.C. § 103

The Examiner has firstly objected to claims 1-36, 39-42 and 45 on the basis that they are obvious in view of *Dymetman* (US6,330,976) when taken with the teachings of *Lieberman* (US5,855,369).

The Applicant, again, respectfully disagrees the Examiner's opinion and requests withdrawal of the claims rejections. In support of the Applicant's submissions, the Examiner's attention is drawn to the MPEP guidelines at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" which states the following:

"...three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in the Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed Cir. 1991)"

In this regard, the Applicant submits that not all claim limitations are taught within the cited documents and therefore a *prima facie* finding of obviousness cannot properly be established given that a person of ordinary skill in the art could not be expected to combine non-existent integers in the citations so as to arrive at the claimed invention.

In particular, the Examiner states that *Dymetman* fails to teach of a "product label" for enabling entry into a competition. Thereafter, the Examiner proceeds to argue that

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Lieberman teaches of a competition "entry form" which may be a "product label", and, suggests that it would be obvious for the person of ordinary skill in the art to combine it with the *Dymetman* technology so as to render the present invention as being obvious.

Lieberman entirely fails to either teach or suggest that the "entry forms" may be product labels provided on the product item. The Applicant notes that *Lieberman* provides a relatively detailed list of examples of "entry form" formats (eg., in the form of ATM receipts, coupon distributed in newspapers, mailers, flyers, tearable coupons disposed on posters). The notable absence from the list of examples of a "product label" format for the "entry forms" is strongly indicative that this was not envisaged by *Lieberman*.

The Examiner has also sought to argue that the "entry forms" taught by *Lieberman* fall within the definition of a "product label" as defined by the *American Heritage Dictionary (AHD)*. Specifically, the Examiner states that the definition of the term "label" in the AHD means:

"an item used to identify something or someone"

However, to suggest that an "entry form" can be construed as a product label simply because it "identifies something or someone", is an overly broad and absurd construction of the term "label" which should therefore be rejected. Moreover, with respect, the Examiner has quoted the definition in the AHD out of context. The correct definition in the AHD for the term "label" is:

"an item used to identify something or someone, as a small piece of paper or cloth attached to an article to designate its origin, owner, contents, use or destination."

Lieberman fails to teach that the "entry forms" are attached to or otherwise provided on the products themselves, and therefore, it cannot be construed as a "product label" within the meaning of claim 1.

Even in the event that the "entry forms" taught by *Lieberman* can broadly be construed as being "product labels", the Applicant submits that there would be no motivation for a person

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of ordinary skill in the art to combine the technology of *Dymetman* with the "entry forms" of *Lieberman*.

For instance, *Lieberman* teaches away from having "entry forms" being included on, or taking the form of, a "product label" because it would be generally inconvenient for an entrant to have to detach the product label from the product in order to submit the entry form in to the competition. Furthermore, *Lieberman* states at col 6, lines 9-12 that:-

"entrants enjoy the option to select a method of entering the prize drawing which does not require them to give anything of value in order to admitted to participation in the drawing"

Thus, if the "entry forms" were to take the form of "product labels", then this would appear to contradict the above statement in that a person seeking to enter the competition would need to first purchase the product in order to acquire the "entry form", and, could not freely participate in the competition by for instance simply collecting a stand-alone "entry form" in the form of a free coupon for instance.

In view of the preceding submissions, and the failure to meet the requirements of the MPEP guidelines for establishing obviousness, the Applicant respectfully requests withdrawal of the present rejection against claim 1 and its dependent claims. The Applicant further requests withdrawal of the Examiner's obviousness rejection of the remaining independent claims and their dependent claims based on arguments similar to those outlined above in respect of claim 1 and its dependencies.

Allowable Subject Matter

The Applicant submits that the rejection of claims 37, 38, 43 and 44 for being based on a rejected base claim (claim 1) should now be withdrawn. The Applicant submits that, in view of the arguments outlined above, the obviousness rejection against claim 1 should properly be withdrawn and thus, the present rejection should also be withdrawn.

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CONCLUSION

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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